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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,332	02/06/2004	Jonathan W. Goodin	91470/MGB	4509

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PATENT LEGAL STAFF
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EXAMINER

ZIMMERMAN, JOSHUA D

ART UNIT	PAPER NUMBER
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2854

DATE MAILED: 09/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/772,332

Applicant(s)

GOODIN, JONATHAN W.

Examiner

Joshua D. Zimmerman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 12-16 are rejected under 35 U.S.C. 102(b) as being anticipated by DeBoer et al. (US 6,044,762).

Regarding claim 12, DeBoer et al. disclose “a printing apparatus comprising

- a. an inking means for inking a lithographic printing master (column 3, lines 50-51 and column 8, lines 37-46”,
- b. a means for applying fountain solution (column 8, lines 32-36) to at least one of
 - i. a lithographic precursor and
 - ii. a lithographic printing master,
- c. a deposition means capable of imagewise depositing coalescing agent on a lithographic precursor (column 7, lines 50-53).”

Regarding claim 13, DeBoer et al. further disclose “further comprising,

- a. a coating means capable of coating imageable medium onto a lithographic base (column 5, lines 43-46) and
- b. a curing means capable of curing imageable medium that has been coated onto a lithographic base (column 5, lines 45-47).”

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Examiner refers applicant to lines 1-5 on page 13 of applicant's specification, which defines curing as drying.

Regarding claim 14, DeBoer et al. disclose "an apparatus for making a lithographic printing master, the apparatus comprising

- a. a coating means capable of coating an imageable medium onto a lithographic base (column 5, lines 43-46),
- b. a curing means capable of curing the imageable medium that has been coated onto the lithographic base, thereby to form a lithographic precursor (column 5, lines 45-47), and
- c. a deposition means capable of imagewise depositing coalescing agent on a lithographic precursor to form an imaged precursor (column 7, lines 50-53)."

Examiner refers applicant to lines 1-5 on page 13 of applicant's specification, which defines curing as drying.

Regarding claim 15, DeBoer et al. further disclose "further comprising a means capable of treating the imaged precursor with a developer (column 8, lines 32-36)."

Regarding claim 16, DeBoer et al. further disclose "wherein the developer is one of

- a. fountain solution (column 8 lines 32-36) and
- b. a liquid comprising tap water."

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBoer et al. (US 6,044,762) in view of Takahashi et al. (US 5,569,573), Kawamura et al. (US 6,566,029) and Yanaka et al. (US 6,596,455).

Regarding claim 1, DeBoer et al. teach "a method for making a lithographic printing master, the method comprising the steps of:

- a. providing a printing precursor comprising on a lithographic base an imageable coating (column 3, lines 37-41)
- b. imagewise converting the imageable coating with a liquid coalescing agent (column 3 lines 37-41) and
- c. removing the areas of the imageable coating that have not been imagewise converted using a developer (column 4, lines 2-3)."

DeBoer et al. fail to teach that "the imageable coating compris[es] hydrophobic polymer particles." However, Takahashi et al. teach the use of microcapsules to increase printing durability and print clarity (column 21, lines 60-63). Kawamura et al. teach that encapsulating a reactive component of an image recording layer limits premature reactions, decreasing the occurrence of stains and improving the on-press

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developability (column 12, lines 19-34). Further, Yanaka et al. teach the use of microcapsules in order to isolate a thermally reactive compound from a co-reactant in order to improve on-press developability and to improve both storage stability and printing durability (column 9, lines 5-11). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to encapsulate at least portions of the imageable coating of DeBoer et al. in order to decrease scumming and/or improve print clarity and/or increase printing durability and/or decrease stains and/or improve the on-press developability and/or improve the storage stability as taught by Takahashi et al., Kawamura et al., and Yanaka et al.

Regarding claim 2, if the imageable medium of DeBoer et al. contains particles (microcapsules) as described above, the coating of the particles serve as a coalescence inhibitor.

Regarding claim 3, DeBoer et al. further teach "wherein the step of providing comprises the steps of

a. coating of a layer of imageable medium onto the lithographic base (column 5, lines 43-45) and

b. curing the layer to form the imageable coating (column 5, lines 45-47)."

Examiner refers applicant to lines 1-5 on page 13 of applicant's specification, which defines curing as drying.

Regarding claim 4, DeBoer et al. further teach "comprising the further step of heating the imagewise converted imageable coating (column 8, lines 25-28)."

Regarding claim 5, DeBoer et al. further teach "wherein the method is performed on a lithographic press (column 8, line 39 and Abstract)."

Regarding claim 6, DeBoer et al. further teach "wherein the method is performed on a lithographic press (column 8, line 39 and Abstract)."

Regarding claim 7, DeBoer et al. further teach "wherein the liquid coalescing agent comprises at least one of a hydrocarbon, an ether, an ester, a glycol, a carbonyl and an alcohol (column 5, line 65- column 6, line 6)."

Regarding claim 8, DeBoer et al. further teach "wherein the coalescing agent additionally comprises at least one of

- a. an indicator dye (column 7, lines 47-49),
- b. a surfactant (column 7, lines 34-35),
- c. a biocide (column 7, line 41) and
- d. a substance capable of modifying the electrical conductivity of the coalescing agent (column 7, lines 44-45)."

Regarding claim 9, DeBoer et al. further teach "wherein the developer is an aqueous developer (column 5, lines 21-26 and column 8, lines 33-36)."

Regarding claim 10, DeBoer et al. further teach "wherein the aqueous developer is one of

- a. fountain solution (column 5, lines 21-26 and column 8, lines 33-36)."and
- b. a liquid comprising tap water."

Regarding claim 11, DeBoer et al. further teach "wherein the developer is fountain solution (column 5, lines 21-26 and column 8, lines 33-36)."

Response to Arguments

3. Applicant's arguments filed 07/18/2006 have been fully considered but they are not persuasive.

U.S.C. 102(b) Arguments

Applicant argues that DeBoer et al. fail to disclose that the deposition means, inking means and the fountain solution applying means are combined in the same apparatus. However, an apparatus is defined as "a group or combination of instruments, machinery, tools, materials, etc., having a particular function or intended for a specific use." The 'combination of instruments' disclosed by DeBoer et al. constitute an apparatus in a broad interpretation of the word, even though the 'instruments' may not be physically connected.

Regardless, applicant fails to claim any sort of physical relationship between all of the elements claimed. As such, DeBoer et al. disclose all the limitations of the claimed apparatus.

U.S.C. 103(a) Arguments

Applicant argues that the liquid applied by DeBoer et al. is not a coalescing agent. However, applicant uses glycols and alcohols as coalescence inhibitors, and even defines them as such in claim 7. DeBoer et al. clearly use glycols and alcohols in their liquid (column 5 line 65 through column 6, line 6). Therefore, by applicant's definition, DeBoer et al. use a 'coalescing agent.'

Applicant further argues that the imaging method of DeBoer et al. is different from the instantly claimed imaging method. Examiner disagrees. Applicant's invention, as claimed in step b of claim 1, requires imaging by "imagewise converting the imageable coating with a liquid coalescing agent." Since the liquid applied by DeBoer et al. is indeed a liquid coalescing agent as described in the immediately preceding paragraph, and the imaging step of DeBoer et al. results in a conversion of the imageable coating in the imaged areas to an image, the modified method of DeBoer et al. clearly meets the claim limitation.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua D. Zimmerman whose telephone number is 571-

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272-2749. The examiner can normally be reached on M-R 8:30A - 6:00P, Alternate Fridays 8:30A-5:00P.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached on 571-272-2258. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Joshua D Zimmerman
Examiner
Art Unit 2854

jdz


JUDY NGUYEN
SUPERVISORY PATENT EXAMINER